

## **II. REMARKS**

The Office Action mailed on March 3, 2006 (the “Office Action”) rejected claims 21 and 36 under 35 U.S.C. § 112, second paragraph, as indefinite in its use of “approximately” as a claim term. The Office Action also rejected claims 1-3, 5-8, 11-16, 18-24, 27, 29-39, and 42 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication 2001/0041991 by Segal et al. The Office Action then rejected claims 4, 9, 10, 17, 25-26, 28, and 40-41 as obvious under 35 U.S.C. § 103(a) over the combination of Segal with U.S. Patent Application Publication 2002/0010679 by Felsher. In this Response, applicants present amended claims as shown above, traverse the rejections from the Office Action, and respectfully request prompt action toward allowance of this application.

Applicants have amended claims 15, 32, and 44 as shown above. These amendments are clearly only to correct typographical errors, and do not affect the scope of the claims at all.

Claims 21 and 36 each recite that the medical history record is stored on something that “is approximately the size of a conventional credit card.” The Office Action rejected those claims, saying that “the term ‘approximately’ is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.” (Office Action, paragraph [2][A].) To the contrary, credit cards do have standard dimensions (defined by ISO/IEC standard 7810). Further, MPEP § 2105(b) identifies “about” (having meaning close to “approximately”) as a claim term that has been held acceptable under § 112. The single case cited in that section that holds “about” to be indefinite noted the close art that made it necessary there to precisely define the limitation. There is no such close art cited in this application. Furthermore, paragraph [0067] of the present application provides a guideline for the scope of “approximately the size of a conventional credit card”: “so as to be easily carried in a wallet.” Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph.

Among other things, claim 1 recites “receiving medical information ... configuring said information into a medical history record ... and [] transmitting said medical history record to a remote record output node which record output node is configured to save said medical history record on [a] portal readable storage medium ... .” Applicants respectfully submit that Segal neither shows nor suggests a method that includes these steps. If, as applicants understand the

Office Action to suggest, Segal has an “information input node” as Internet computer workstation 306 (referring to Segal paragraph [0104]) and “receiving” happening at Segal’s clinical database 118 (referring to Segal paragraph [0110]), then there is no “transmitting [of the] medical history record to a remote record output node which record output node is configured to store said medical history record on said portable readable storage medium” as recited in the claim. Because of this missing element, applicant respectfully requests withdrawal of the rejection of claim 1 over Segal. Further, since claims 2 and 14 depend from claim 1, those claims are also patentable over Segal.

Among other things, claim 15 recites “transmitting medical information through [an] information-transmission connection to [a] record-creating node, said record-creating node being adapted to configure said information into a medical history record ... receiving said medical history record from said record-creating node; [and] storing said medical history record on [a] portable readable storage medium.” In contrast, Segal neither shows nor suggests these transmitting/configuring-receiving-storing steps as claimed. For example, Segal does not show transmitting medical information to any node, then receiving a “medical history record” from the node and storing the record on a portable readable storage medium. Because this recited combination of steps is not shown by Segal, applicants respectfully request that the rejection of claim 15 be withdrawn. Further, claims 16-29 depend from claim 15 and are, therefore, patentable over Segal for the same reason.

Among other things, claim 30 recites “a record-creating node ... for configuring [] information into a medical history record and for transmitting said medical history record; [and] a record output node, remote from said record-creating node, for receiving said medical history record ... and for storing said medical history record on a portable readable storage medium.” As discussed above, Segal does not show separate record-creating and record output nodes having the features claimed. For example, the Office Action cited Segal’s paragraph [0151] as showing storing the medical history record on a portable readable storage medium, but that paragraph suggests local input and storage of medical information on a portable storage medium without the claimed remote record-creating node. Because the combination of elements recited in claim 30 is not shown or suggested in Segal, applicants respectfully request that the rejection of that claim be withdrawn. For the same reasons dependent claims 31-44 are patentable over Segal.

Applicants observe that claims 4, 9-10, 17, 25-26, 28, and 40-41 were rejected as obvious over the combination of Segal and Felsher. Felsher, however, does not cure the defects in Segal as to the parent claims of those rejected under § 103(a), so applicant respectfully submits that the obviousness rejections fail to present the required prima facie case and should be withdrawn. Further, there is no motivation in the references to combine them to achieve the methods and apparatus recited in those claims. That is, Felsher mentions public key encryption, but does not suggest including it in the methods and systems now recited in the claims of this application.

Furthermore, all elements of the dependent claims are not shown in the cited art. For example, claim 3 recites “encrypting said medical history record prior to transmitting said medical history record to said record output node.” As discussed above, Segal fails to show the “transmitting” step of claim 1, so the additional step recited in claim 3 clearly is not shown by Segal.

Likewise, claim 5 recites that the “transmitting step [of claim 1] comprises transmitting said medical history record to a remote record output node, *which record output node is configured to store the medical history record on the portable readable storage medium and to allow a medical practitioner to inspect the medical history record prior to storage of the medical history record.*” (Emphasis added.) Segal neither shows nor suggests a record output node with these capabilities. Applicant respectfully requests withdrawal of the rejections of claims 3 and 5 for the independent reasons just given.

The present Response is believed to put the application in condition for allowance, and prompt action by the Office toward that end is respectfully requested. In the event any issue(s) remain that may be resolved by telephone, the undersigned invites the Examiner to contact the undersigned by telephone to expedite the examination of this application. Thank you.

Respectfully submitted,

/Matthew R. Schantz/

Matthew R. Schantz, Attorney Reg. No. 40,800

BINGHAM McHALE, LLP  
2700 Market Tower  
10 West Market Street  
Indianapolis, IN 46204-4900  
Telephone: (317) 635-8900  
Facsimile: (317) 236-9907  
mschantz@binghammchale.com  
8506-62259/1061963